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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,598	07/10/2003	Alberto Cavallaro	74086	3623

22242 7590 07/18/2005

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,598

Applicant(s)

CAVALLARO ET AL.

Examiner

D. S. Nakarani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/17/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The use of the trademark THERMOBOND 615, THERMOBOND 650, and SURLYN in the amended paragraph on page 7 lines 2-7 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks. The trademarks "THERMOBOND 613 THERMOBOND 650, and SRLYN" are not sold as thermoplastic laminates as stated in the paragraph. These materials are laminating thermoplastic adhesives. In the amended paragraph these trademarks are not accompanied with the generic terminology as required.

The trademarks "THERMOBOND 615, THERMOBOND 650, and SURLYN" are not sold as thermoplastic laminates as stated in the paragraph on page 7. These materials are laminating adhesives. In the amended paragraph these trademarks are not accompanied with the generic terminology as required.

3. Claims 6 and 10 are objected to because of the following informalities: claims 6 and 10, line 2, the article "an" should read - - a - -. Appropriate correction is required.

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4. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the limitation "formable silicone containing microcapsules". The specifications as originally filed provide support for the reactive liquid silicone containing microcapsules. The phrase "formable silicone" does not mean it is a reactive liquid silicone. The specifications at page 2, line 25 to page 3, line 22 does not provide support for the limitation "formable silicone containing microcapsules".

5. Claims 1 and 4-21 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the reactive liquid silicone containing microcapsules, does not reasonably provide enablement for the non-reactive silicone containing microcapsules. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. There is no evidence provided in the specification that non-reactive silicone (solid or liquid) containing microcapsules will provide required release coat for removal of the protective coating.

6. Receipt of supplemental Information Disclosure statement filed March 17, 2005 is acknowledged. The non-patent literature documents list provided with the Supplemental Information Disclosure listed substantially all references listed on page 2 of the PTO/SB/08B submitted with the Information Disclosure statement filed July 10, 2003. Since the list is

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missing two references, the PTO/SB/08B has been signed and the list submitted on March 17, 2005 has been crossed out to prevent duplicate citation. The non-patent literature documents showing no publication date have been considered but crossed out and will not be listed on the patent published from this application. If applicants desire to list crossed-out documents on the patent published from this applications, documents showing publication date should be submitted with PTO 1449.

7. Applicant's arguments filed on March 17, 2005 have been fully considered but they are not persuasive. In reference to rejection of claims 1 and 4-21 under 35 USC § 112, first paragraph for the specification enabling for the microcapsules containing reactive liquid silicone, applicants have amended claims to limit "formable silicone containing microcapsules" and stated that the specification at page 2, line 25 to Page 3, line 22 provide support for the silicone in the microcapsules is formable.

These arguments are unpersuasive because the silicone in the microcapsules is formable does not mean it is a reactive liquid silicone. Non-reactive silicone (solid or liquid) is also formable in different shape under pressure and/or heat.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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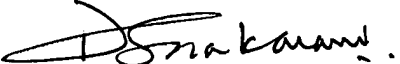
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday thru Fridays from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nakarani/LR
June 2, 2005


D. S. NAKARANI
PRIMARY EXAMINER